

5d



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,049	04/27/2001	Shigeru Fukutake	F-6966	2699

7590

10/05/2004

Jordan and Hamburg
122 East 42nd Street
New York, NY 10168

EXAMINER

GYORFI, THOMAS A

ART UNIT PAPER NUMBER

2135

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

5d

Office Action Summary

Application No.

09/844,049

Applicant(s)

FUKUTAKE ET AL.

Examiner

Tom Gyorfi

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2135

1. Claims 1-18 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over RFC 2058 ("Remote Authentication Dial In User Service (RADIUS)", published January 1997), and as appropriate in view of Tianen et al. (PCT Patent WO 99/37055).

Regarding claims 1 and 10, RFC 2058 teaches an authentication mechanism to allow users to connect to the Internet. It teaches a network access server and one or more authentication servers (RFC 2058, page 3, "Client/Server Model"). Note that in at least one embodiment of RADIUS, one RADIUS server can transfer user authentication requests to another RADIUS server when a predetermined condition is met (RFC 2058, page 5, "The RADIUS server MAY make requests..."). The authentication server that makes the decision has a database associated with it (RFC 2058, page 5, "...the RADIUS server consults a database of users..."). The decision is relayed back to the network access server, via any intermediary RADIUS servers as necessary (RFC 2058, page 7, "The server then sends back..." and page 5, "The RADIUS server MAY make requests...in which case it then acts as a client."). The network access server then acts

Art Unit: 2135

based upon the result returned by the servers (RFC 2058, page 3, "A Network Access Server (NAS)...acting on the response which is returned.").

Although RFC 2058 is silent regarding the ownership of the servers involved in the system, it is considered to be inherently true of RADIUS servers that the ownership has no effect on the functionality of properly configured servers, and therefore the servers being owned by separate enterprises is immaterial. In the event that Applicant challenges this view, it can be shown to be an obvious development in view of the Tianen patent. Tianen teaches a system for providing remote access for a plurality of host computer networks and their respective authorized users by means of a network access server operated by a third party service provider (Tianen, "Abstract" and also page 2, lines 13-15). Note that the network access server as disclosed by Tianen performs the same function as the authentication server disclosed by both RFC 2058 and Applicant (Tianen, page 7, lines 14-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to establish that at least one authentication server used in an implementation of RFC 2058 could be owned by a third party enterprise, different from the owner of the first authentication server. Tianen further teaches that a motivation for having a third party perform authentications is to reduce the infrastructure and overhead burden on individual organizations, which is beneficial particularly when the organization providing the desired product or service is too small to provide its own authentication service (Tianen, page 1, lines 21-23 and also page 2, lines 9-12).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over RFC 2058 [and Tianen] as applied to claims 1 and 10 above, and further in view of the article "Alternate Names Used for Addressing in OfficeVision/2" (IBM Technical Disclosure Bulletin Volume 35, Issue 6; henceforth "IBM").

Regarding claims 2 and 11, note that RFC 2058 teaches that authentication requests contain a user-name, which is a code for specifying a user (RFC 2058, page 20, "5.1 User-Name"), and also a proxy-state code which, when present, indicates that a RADIUS server should forward the request to a different authentication server (RFC 2058, page 48, "5.33 Proxy-State"). Note that the proxy-state code is not a component of the user name, but a separate field in the authentication request. However, IBM teaches a software product which had the capacity to resolve a username into a bipartite code containing a user id and a node id (IBM, lines 1-4 of the disclosure text). In particular, the node id can be construed as a predetermined code, and it is clearly contained within the body of the user name, a.k.a. the account code. This reference is deemed analogous art as both it and the instant application pertain to account code management. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permit the use of a predetermined code, similar to a

node id from the IBM disclosure, as part of the username required by the RADIUS authentication system, and to set the proxy-state field of the authentication request to forward it to another RADIUS server if said code is detected within the username. By doing so, one can use the same authentication hardware to authenticate and distinguish between multiple services without requiring significant upgrades.

6. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over RFC 2058 [and Tianen] as applied to claims 1 and 10 above, and further in view of Nguyen et al. (U.S. Patent 6,006,334).

Regarding claims 4 and 13, neither RFC 2058 nor Tianen teach a lobby server for providing a chance to find a negotiation partner among a plurality of users on the Internet as the server for which access needs to be granted. However, Nguyen teaches that at the time of the invention Blizzard Entertainment Inc. had already established a computer game matchmaking service called Battle.Net™, comprising one or more lobby servers where players of the computer game Diablo™ could meet online and play with each other (Nguyen, column 1, lines 31-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the access control method of RFC 2058 as the authentication method for access to a lobby server such as the Battle.Net™ service taught by Nguyen. With a proper authentication scheme in place, one can more easily verify that the only users allowed on the lobby server are those who have legitimately purchased a copy of the game or computer program that one desires to use online (Nguyen, column 1, lines 36-41).

Art Unit: 2135

7. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of RFC 2058, [Tianen], and IBM as applied to claims 2 and 11 above, and further in view of Nguyen (U.S. Patent 6,006,334) and also in view of the instruction manual for the computer game Starcraft™ (©1998 Blizzard Entertainment).

Regarding claims 3 and 12, again note the lobby server and the services it provides as found in the text of the Nguyen patent (Nguyen, column 1, lines 31-36). In addition, it must be noted that in order to utilize the predetermined services offered by Battle.Net™, one must log in with a Battle.Net ID (Starcraft manual, page 8, "Battle.Net requires the creation of a separate Battle.Net ID."). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a username containing a predetermined code, such as the one found in the teachings of RFC 2058 as modified by IBM [and Tianen]), as the account code for utilizing a predetermined service on a server provided by a second enterprise (for example, as the Battle.Net ID for use on Battle.Net, as disclosed by Nguyen and the Starcraft manual). Doing so would simplify administrative duties for the enterprise hosting the servers featuring the predetermined service, as the alternative would be to require a separate set of account codes on the authentication server distinct from those recognized by the servers providing a predetermined service, and correlating the two sets of account codes would require considerable effort.

8. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over RFC 2058 [and Tianen] as applied to claims 1 and 10 above, and further in view of RFC

Art Unit: 2135

2059 ("Radius Accounting", published January 1997) and also Peterson et al. (U.S. Patent 6,349,289).

Regarding claims 5 and 14, RFC 2058 does not teach detecting devices that can track a user's history of connecting to the Internet, nor track a user's history of utilizing a service from a server. However, the companion document RFC 2059 teaches additional functionality, in the form of Radius Accounting servers, that work in conjunction with Radius authentication servers to track accounting information (RFC 2059, page 2, "Introduction", 2nd paragraph). Of particular interest is the capability for Radius to generate a record of the type of service provided and the duration (RFC 2059, pages 3-4, "Operation", 1st paragraph). Such information would constitute a history of service utilization; further, since the service being rendered necessarily requires one to be connected to the Internet, this record also constitutes a history of Internet usage as well. It can also be said that any server that keeps track of such accounting information can be construed to be a detecting device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the Radius accounting features described in RFC 2059 into the Radius authorization system described in the rejection of claims 1 and 10. It is clear from the cited references that the two Radius components were designed from the outset to interoperate, and that its inventors encouraged this practice. Even were that not so, adding an accounting feature to an authentication system would give the administrators the beneficial ability to audit the access records, in order to verify the proper functioning of the authentication system.

Further regarding claims 5 and 14, neither RFC document teaches the use of an account-information generating device that is capable of assessing an access charge to the user based on the usage history observed by detection devices. However, Tianen teaches a method for tracking computer system usage through a remote access security device, which includes a billing server that is capable of assessing service fees for the use of a target computer network (Peterson, column 2, lines 50-60). Further, a billing application is run that gathers the necessary billing information by communicating with both the ESS server and a network access server (Peterson, column 3, lines 13-17). It should again be noted that the network access server disclosed by Peterson performs the equivalent function of the authentication servers disclosed by both Applicant and the RFC documents. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the billing mechanism disclosed in Peterson into a Radius system as taught by RFC 2058, modified to include accounting functionality as per RFC 2059. Billing a user based on one's usage history could be seen as a more efficient alternative to billing for a service with a flat fee per month, particularly when a large number of users make frequent use of the service being offered.

9. Claims 6-8 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of RFC 2058, RFC 2059, [Tianen], and Peterson as applied to claims 5 and 14 above, and further in view of Deaton et al. (U.S. Patent 6,611,811).

Regarding claims 6 and 15, none of the previously cited references teach that a discount condition can be applied by an accounting information generating device. Note that it is understood that a discount condition by definition would mean that the charge for a product or service would be less when the condition is applied than it would be were the discount not applied. Furthermore, Deaton teaches a method by which discounts can be applied to items purchased on the Internet (Deaton, column 1, line 66 – column 2, line 13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the accounting information generating device as found in the combination of RFC 2058, Peterson, and Tianen to permit discounts on the products being sold or services being rendered by the second enterprise. As Deaton teaches, providing discounts is likely to induce users into continuing to use the offered services or to purchase additional products from the enterprise offering said discounts (Deaton, column 2, lines 22-24).

Regarding claims 7, 8, 16, and 17, nothing in the combination of references above teach that the discount condition above could be based on the user exceeding a predetermined amount of money in one's purchases of the product or service sold by the second enterprise. However, Deaton teaches a method by which discounts can be applied, both on individual items in an order and on the order as a whole, when the cumulative price of the order exceeds a predefined threshold (Deaton, column 1, lines 53-65). Also, note that it is clearly the case that the user must be actively purchasing items from the seller for the discount to be applied; ergo the predetermined discount condition found in Deaton is associated with utilization of the user relevant to the service

provided by the enterprise. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to define a threshold for a user's purchases of a product or service, such that a discount condition could be applied if the charge to the user exceeds said threshold. Offering discount incentives to a user in this fashion is preferable because it provides the appearance that a customer's desired products are on sale, which in turn induces said customer into future purchases from that seller (Deaton, column 2, lines 15-24).

10. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of RFC 2058, RFC 2059, Peterson, [Tianen], and Deaton as applied to claims 7 and 16 above, and further in view of Acres (U.S. Patent 6,565,434).

Regarding claims 9 and 18, none of the preceding combination of references teach a game as the service provided by the server, nor that a discount condition can be applied if a certain game state is reached. However, Acres teaches a networked gaming system controlled by a server that is capable of awarding prizes and bonuses to players (Acres, Figure 5 and column 17, lines 27-34). Of particular relevance is the Welcome Back bonus, which can be earned by players who have acquired a requisite number of points through playing the games; the Welcome Back bonus in one embodiment of the system is a half-price discount (Acres, column 11, lines 8-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to establish that the server protected by the authentication mechanism disclosed by the combination of RFCs 2058 and 2059, [Tianen], Peterson,

Art Unit: 2135

and Deaton should be a pay-for-play game server, and further for said server to reward players with a discount based on the user's performance in said game. Rewarding players with occasional bonuses and discounts serves to induce the players to continue playing in the hopes of winning further, thus ultimately providing the owner of the server with increased revenue.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:00am - 4:30pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TAG - 09/24/04


KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2135